



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

8

Application Number

09/933,683

Filing Date

August 20, 2001

First Named Inventor

Michelle A. BUTLER

Art Unit

2623

Examiner Name

Shirley Chang

Attorney Docket Number

50588/174

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____

☐ Landscape Table on CD

After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):Request for Pre-Appeal Conference.
Return receipt postcard.

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Stoel Rives LLP, 900 SW Fifth Avenue, Suite 2600, Portland, Oregon 97204

Signature

Printed name

Matthew C. Phillips

Date

July 6, 2006

Reg. No.

43,403

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

George Painter

Date

July 6, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500.00

Complete if Known

Application Number	09/933,683
Filing Date	August 20, 2001
First Named Inventor	Michelle A. BUTLER
Examiner Name	Shirley Chang
Art Unit	2623
Attorney Docket No.	50588/174

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 19-4455 Deposit Account Name: Stoel Rives LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fees Paid (\$)
- 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Notice of Appeal

Fees Paid (\$)

500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 43,403	Telephone (503) 224-3380
Name (Print/Type)	Matthew C. Phillips		Date July 6, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Confirmation No. 6383

Michelle A. BUTLER and Robert E. NOVAK

Application No. 09/933,683

Filed: August 20, 2001

For: **METHOD AND SYSTEM FOR PROVIDING IMPROVED USER INPUT
CAPABILITY FOR INTERACTIVE TELEVISION**

Group Art Unit: 2623

Examiner: Shirley Chang

REQUEST FOR PRE-APPEAL CONFERENCE

TO THE COMMISSIONER FOR PATENTS:

The Applicants request review of the final rejection of claims 22-31 and 34-43 in the Office action dated April 6, 2006 in the above-identified application.

This request is being filed with a timely Notice of Appeal.

Claims 22-31 and 34-43 are in the application, all of which stand rejected under 35 U.S.C. § 103 as being allegedly obvious over Bulman (U.S. Patent No. 6,351,265)¹ in view of Hornbuckle (U.S. Patent No. 5,388,211). Claims 22 and 34 are in independent form. Claim 22 is representative for purposes of this request.

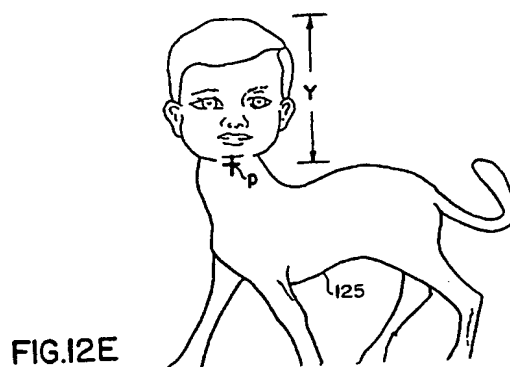
No amendments are being filed with this request.

¹ The pertinent Bulman reference is U.S. Patent No. 6,351,265. The reference cited in the Office Action (U.S. Patent Appl. Pub. No. 2003/0051255) is not § 102(e) prior art, as it was filed on February 25, 2002 – after the present Applicants' filing date (August 20, 2001). U.S. Patent Appl. Pub. No. 2003/0051255 is a continuation-in-part of the application from which U.S. Patent No. 6,351,265 issued. Any new matter added to the U.S. Patent Appl. Pub. No. 2003/0051255 vis-à-vis U.S. Patent No. 6,351,265 cannot be applied against the present Applicants' claims. Therefore, all references to Bulman herein will be to U.S. Patent No. 6,351,265.

Reasons for Requesting Review

A. The Bulman Reference.

In relevant part, Bulman teaches a system for superimposing a human's face or head on another creature's body in a video segment. Bulman's Figure 12E illustrates this concept:



Bulman uses one or more pictures of a human subject's head or face, obtained from scanning a photograph or from a camera, as shown in Figure 2. These pictures are appropriately cropped and scaled and then superimposed on another creature's or character's body in a "background" video clip. One application of Bulman's system is to create a personalized video story for children.

Bulman also teaches that the soundtrack for the video may be custom tailored. To do so, the custom video creator speaks the pictured subject's name into a microphone, creating a digitized speech segment, which can be overlaid into the background soundtrack at the appropriate times. *See* Bulman's Example 4 on column 10, lines 9-63 and corresponding Figures 8 and 9. Bulman notes that a textual form of the pictured subject's name can be updated in a close-caption signal, if close-captioning is supported. *See* column 12, lines 28-54.

B. The Rejection of Claim 22.

Claim 22 reads as follows:

22. A method, comprising:
- receiving electronic information in an interactive format via a television system;
 - displaying said electronic information, including text from said electronic information, for viewing by a viewer;
 - providing a narration of said text substantially contemporaneously with displaying said text;

receiving payment information for accessing said electronic information;
 wherein said payment comprises a rental charge for accessing said electronic information;
 accepting input other than payment information from a said viewer; and
 modifying said electronic information based on said input, thereby adapting a result of performing at least one of the displaying step or the providing step.

The Applicants' specification discloses examples of this method, wherein the "electronic information" is supplemental information sent from a television head-end or cable network to a viewer's set top box.

The rejection equates the recited "electronic information" with Bulman's picture(s) of the human subject's face/head, contends that Bulman's close-captioning corresponds to the recited "narration," and asserts that the recited step of "modifying the electronic information" reads on Bulman's insertion of a spoken name (e.g., "Jason") into the story's audio track. The following claim table summarizes the rejection of claim 22 on a limitation-by-limitation basis:

<u>Claim 22</u>	<u>Bulman (according to Office action)</u>
receiving electronic information in an interactive format via a television system;	Images of pictured human subject "in NTSC format" (col. 10, lines 1-6)
displaying said electronic information, including text from said electronic information, for viewing by a viewer;	Displaying the pictured human's head/face superimposed on another's body. <i>See</i> Figs. 6 and 7.
providing a narration of said text substantially contemporaneously with displaying said text;	Close-captioning (col. 10, lines 8-63)
receiving payment information for accessing said electronic information;	Hornbuckle
wherein said payment comprises a rental charge for accessing said electronic information;	Hornbuckle
accepting input other than payment information from a said viewer; and	The name of the human subject spoken into the microphone 52 (Fig. 9)
modifying said electronic information based on said input, thereby adapting a result of performing at least one of the displaying step or the providing step.	Inserting the spoken name in the audio soundtrack (col. 10, lines 27-63; Fig. 8)

C. Bulman Fails to Disclose At Least Two Limitations in Claim 22.

There are several flaws with the rejection's reading of Bulman on Claim 22. At least two of those flaws relate to (1) the combination of the "receiving" and "displaying" steps and (2) the step of "providing a narration."

1. Bulman Fails to Disclose "Receiving Electronic Information in a Interactive Format via a Television System" and "Displaying Said

Electronic Information, Including Text From Said Electronic Information.

According to the rejection, the “electronic information” in Bulman’s system are the picture images of the human subject’s face/head because the claim states that this “electronic information” is received “via a television system,” and Bulman discloses that his human subject pictures are converted to an “NTSC format which is then recorded on a VCR” (column 10, lines 5-6). The rejection then points to Bulman’s Figures 6 and 7 to allegedly show that the “displaying” step is met by Bulman, as Bulman does display the subject’s picture superimposed on a background scene. However, the “displaying” step in the claim also states that the “text from said electronic information” is displayed. However, Bulman’s human subject pictures in NTSC format clearly have no text. Ergo, no such text can be displayed by Bulman.

Should the Office contend that close-captioning is text, that may be true, but close-captioning is not part of the human subject picture “electronic information.” The human subject picture is just an image. The audio segments of the subject’s name are later spoken into a microphone (the microphone 52 in Figure 9) and form no part of the “electronic information in an interactive format via a television system” – which is the “electronic information” displayed in the “displaying” step.

Hornbuckle, which is cited for its teaching of rental payments, does not cure this deficiency in Bulman.

2. Bulman Fails to Disclose “Providing a Narration of Said Text.”

The rejection further contends that close-captioning corresponds to “providing a narration of said text.” This reasoning is backwards. A narration is spoken words generated to accompany pre-existing video content.² Close-captioning is a special case of the exact opposite: video text generated from spoken words in a television signal. Performing close-captioning is not “providing a narration” of text any more than evaporation is condensation.

Neither Hornbuckle or any other reference of record can rectify this shortcoming in Bulman. The Applicants therefore respectfully request that the rejection of claim 22 be withdrawn for this reason.

² Merriam-Webster Online Dictionary provides a pertinent definition of “narrate” as “to provide spoken commentary for (as a movie or television show).” <http://www.m-w.com/dictionary/narrate> (last viewed July 6, 2006).

Conclusion

The cited patent of Bulman does not teach or disclose certain limitations of independent claims 22 and 34, and none of the other references of record cure those deficiencies in Bulman. The Applicants therefore submit that all of claims 22-31 and 34-43 are patentable over Bulman in view of Hornbuckle and respectfully asserts that the rejection should be withdrawn and the application promptly allowed.

Respectfully submitted,

Digeo, Inc.

Dated: July 6, 2006

By



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